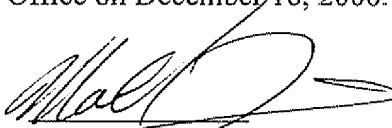


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)	
)	
Bruce P. Konen)	Art Unit: 3723
)	
Serial No.: 10/688,449)	Examiner: Hadi Shakeri
)	
Filed: October 17, 2003)	
)	
For: Pliers with Protected Indicia on)	
the Handles)	
)	
Confirmation No.: 1569)	

I hereby certify that this correspondence is being filed electronically with the EFS-Web system of the United States Patent and Trademark Office on December 18, 2006.


Michael D. Zaronias
Registration No. 54,564

Mail Stop – Appeal Brief
Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is in response to the second supplemental Examiner's Answer mailed on November 14, 2006. As a preliminary matter, we discuss the due date for this Reply Brief. According to 37 CFR 41.41(a)(1) Applicant may file "a reply brief to an examiner's answer within two months from the date of the examiner's answer." In this case an initial Examiner's Answer was mailed on September 29, 2006, then a first supplemental Examiner's Answer was mailed on October 30, 2006 and subsequent to that a second supplemental Examiner's Answer

was mailed on November 14, 2006. The Rules do not specifically address the due date of a reply brief when supplemental Examiner's Answers are filed. It is Applicant's position that the only reasonable interpretation of the Rule is that the two-month time period begins on the date of the *last* Examiner's Answer. In this case the last Examiner's Answer was mailed on November 14, 2006. Accordingly, this Reply Brief is due on January 14, 2007. This position has support in Rule 41.41(a)(1). We do not believe the full two months for a Reply Brief afforded an Applicant in this Rule can be foreshortened by the filing of Supplemental Examiner's Answers.

While we believe the present Reply Brief is not due until January 14, 2007 and thus the present filing is timely, since rule 41.41(a)(1) does not explicitly address the filing of multiple Examiner's Answers, we considered the possibility that the Board might deem Applicant's Reply Brief to have been due two months from the initial Examiner's Answer of September 29, 2006. Applicant as a precautionary measure is filing herewith a Provisional Petition for Extension of Time under 37 CFR 1.136(b). This Petition is only necessary in the event the Board deems the due date of the Reply Brief to have been November 29, 2006. If that is the case, Applicant respectfully requests consideration and granting of an extension of time in view of the extraordinary events which occurred on November 29, 2006 and the diligence of the undersigned's first attempt to file the Reply Brief on that date. These circumstances are fully explained in the form of a declaration in the Provisional Petition.

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I. REAL PARTY IN INTEREST

The real parties in interest in this appeal are IDEAL Industries Inc., assignee of the invention claimed in the above referenced application, which assignment was recorded in the United States Patent and Trademark Office at Reel No. 014627 and Frame No. 0967 on October 17, 2003.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-15 are currently pending and all have been finally rejected in the Office Action mailed November 25, 2005. Applicant is appealing the rejection of pending claims 1-15.

IV. STATUS OF AMENDMENTS

In response to the non-final Office Action mailed June 8, 2005, Applicants filed a response on September 8, 2005 which amended independent claims 1, 6 and 11. Subsequently, the final Office Action mailed November 25, 2005 acted on the previous amendment and finally rejected all the claims, 1-15. No amendments have been made following the final Office Action of November 25, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is generally directed to hand tools having indicia or markings used to identify the particular type of tool. More particularly, the invention relates to hand tools having indicia located on protected surfaces of one or more handles of the hand tool. The invention also encompasses a method of identifying a hand tool.

While it is known to place markers or indicia on a tool handle to indicate the type of tool, these markers or indicia are applied to areas of the tool handle that are susceptible to wear and abrasion and that are susceptible to being obscured by adjacent tools. See paragraph 0003.

To overcome these deficiencies, the subject matter of independent claims 1 and 6 is directed to a hand tool having two handles (10, 12) pivotally connected to one another and terminating at a free end. (See paragraph 0007 and FIGS. 1 and 2). Portions of the handle adjacent the terminating ends are convex and have inner surfaces (24) facing each other. (See paragraph 0008 and FIGS. 1 and 2). In normal, one-handed operation of the tool, the palm and fingers of a user's hand will wrap around and contact the first and second planar surfaces (18, 20) and the outer surfaces (22) of the handles but they will not engage the inner surfaces (24). (See paragraph 0008 and FIGS. 1 and 2). Since each inner surface is protected by the opposite handle, the inner surface is not subjected to wear or abrasion from a user's hand. (See paragraph 0008 and FIGS. 1 and 2). Accordingly, the inner surfaces are also referred to as protected surfaces. (See paragraph 0008).

Indicia or markings (26 or 28) are located on the convex end portion of the inner surface (24) of at least one of said handles (10 or 12) and indicating the type of the tool, or are located on a protected surface (24) of at least one of said handles (10 or 12). (See paragraph 0009 and FIGS. 1 and 2). Claim 11 is a method of identifying a tool having the above-described features except that the indicia are placed on the convex end portion of the inner surface (24) of at least one of said handles (10 or 12).

The advantages the hand tool of the present invention are at least twofold: The indicia or markings are less vulnerable to wear and abrasion which can result in making the marking

unintelligible (see at least paragraph 0008); and the indicia are less likely to be visually obscured by an adjacent tool (see at least paragraph 10 and FIG. 2).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-15 are unpatentable under 35 USC 103(a) over U.S. Patent No. 5,421,224 to Bond (hereinafter, Bond) in view of U.S. Patent No. 3,675,359 to Ohno (hereinafter, Ohno).

B. Whether claims 1-15 are unpatentable under 35 USC 103(a) over Ohno in view of Bond.

VII. ARGUMENT

A. The rejection of claims 1-15 under 35 USC 103(a) over Bond in view of Ohno and over Ohno in view of Bond is in error and must be reversed.

In order to find that claims 1-15 are obvious over a combination of references, it must be shown that the references in combination disclose all the features of the claims and evidence must be provided showing a teaching, suggestion or motivation to combine the references. Applicant submits that the combination of Bond and Ohno do not disclose all the features of the claims and even if the combination discloses all the features, which it does not, there is no evidence nor has there been any showing of evidence of a teaching, suggestion, or motivation to combine Bond and Ohno to arrive at the claimed subject matter.

The features of claim 1 include among others handles terminating at a free end, each handle having first and second planar surfaces joined by inner and outer surfaces, inner surfaces being the portions of said first and second handles facing each other, inner surfaces being convex relative to one another at least at an end portion adjacent the free end, and indicia located on the convex end portion of the inner surface of at least one of said handles. Claim 11 has

substantially the same features except that it is directed to a method of identifying a tool. The features of claim 6 include among others handle portions terminating at a free end, handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, and an indicia located on a protected surface of at least one of said handles.

Bond in Fig. 8 discloses pliers having indicia 70 on the terminal or butt end 72 and indicia 68, 69 on side or outer surfaces of the handles but clearly not on inner or protected surfaces as claimed in the present application. At a minimum, Bond does not disclose inner surfaces (surfaces facing one another) being convex relative to one another at least at an end portion adjacent the free end and indicia located on the convex end portion of the inner surface of at least one of said handles as recited in claims 1 and 11, and does not disclose handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, and an indicia located on a protected surface of at least one of said handles as recited in claim 6.

The handles disclosed in Ohno are similar to Bond except that instead of having butt ends the ends of the handle are tapered. The Ohno reference does not disclose inner surfaces (surfaces facing one another) being convex relative to one another at least at an end portion adjacent the free end and indicia located on the convex end portion as recited in claims 1 and 11, nor does it disclose handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, and an indicia located on a protected surface of at least one of said handles as recited in claim 6.

Therefore, combining Bond and Ohno would still not meet all the limitations of the claims of the present invention.

Furthermore, there is no evidence of a teaching, suggestion or motivation to combine Bond and Ohno. One reason for having the convex end portion and indicia thereon is to be able to view the indicia from above when the tool is in a tool belt and to protect the indicia from wear. There is no disclosure in Bond or Ohno even suggesting the need to protect the indicia from wear. Accordingly, there is no teaching, suggestion or motivation to combine Bond or Ohno and even if combined there is no motivation to modify the tools disclosed in Bond and Ohno to place indicia on inner or protected surfaces or to modify the handles to have convex portions relative to one another as recited in the claims.

The Examiner maintains in the rejection and in the Examiner's second supplemental Answer specifically on lines 5-8 of the first paragraph of section 10 "Response to Argument" that "Bond meets the limitations, i.e., indicia (68) and (69) are on 'a' convex inner surface of the handle, i.e., mid-portion" except that "the convex inner surfaces disclosed by Bond do not face each other." These statements indicate either a misunderstanding of the claim limitations or reading limitations out of the claim. Indeed, on page 6 of the Examiner's second Supplemental Answer reference is made to "inner" surface (quotes in the original) as if the Examiner is not giving this term its common meaning as understood by skilled artisans and as defined by the specification but rather as a nondescript reference akin to labeling the structure as a "first" surface. Further, in order to describe a structure as convex or concave reference or relation must be made to something else. For example, the exterior surface of a football is convex or when viewed from the exterior, the surface is convex. The interior surface of the football is concave. The claims recite inner surfaces facing each other and inner surfaces being convex relative to one another, among other things. Neither Bond nor Ohno disclose handles having such features.

The Examiner also accuses applicant of attacking the references piecemeal or individually. This is clearly incorrect as applicant only points out the features which are disclosed and which are lacking in each reference in order to establish whether combining the references would disclose all the features of the present claims assuming there is a teaching, suggestion, or motivation to combine.

According to the second Supplemental Answer of the Examiner, "Bond as modified by Ohno would result in a pliers type tool having ergonomic handle grips meeting all the limitations as outlined by the Appellant." Specifically, the Examiner indicates that the feature of the claims - *the inner surfaces being convex relative to one another at least an end portion adjacent the free end* - is met by the structure "inner surfaces facing each other all along the length including at or adjacent to the distal end" in the tool of Bond modified by Ohno. (Emphasis added). First, the inner surfaces cannot include the distal or free end since the free ends and inner surfaces are distinctly claimed structures and if the inner surfaces extend to "adjacent the free end" then the those inner surfaces would could not be the *portions of the first and second handles facing each other* nor could those surfaces be *convex relative to one another*.

In addition, Examiner's second supplemental Answer indicates that the feature of the claims *indicia located on the convex end portion of the inner surface* is met by indicia 70 disclosed by Bond except that instead of butt end 72 the modified tool would have curved ends. However, this is not what is recited by the claims. The claims recite handles terminating at a free end and inner surfaces (surfaces facing one another), inner surfaces being convex relative to one another at least at an end portion adjacent the free end and the indicia on the convex end portion not on the free end as in the modified tool of Bond and Ohno. Also, Examiner attempts to indicate that Bond also discloses that the indicia could be placed at locations other than just the

butt end by citing several lines of Bond, which state that the indicia can be located “somewhere along the handle.” This statement in Bond however does nothing to assist in teaching the features of the present claims since this statement is made with respect to handle 12 of the screwdriver not the tool recited in the claims and Fig. 8 of Bond already shows indicia both on the butt end and along the handles of pliers. What is clear is that there is no disclosure on placing the indicia on inner surfaces (surfaces facing one another) and surfaces having a convex end portion even if the teaching of Ohno is combined with the teaching of Bond.

Furthermore, Examiner attempts to explain how Ohno discloses convex inner surfaces facing each other. According to the Examiner “grips 20 as disclosed in Figs. 2 and 3 (parallel lines at the inner edge), indicating convex surfaces facing each other from the proximal end to the distal end” and that applicant admits that Ohno has convex butt surfaces but that they are neither inner nor protected surfaces. First, applicant did not admit that Ohno has convex butt surfaces and applicant does not understand how the above statement indicates that grips 20 have inner surfaces including convex end portions. The Examiner indicates that the surfaces of grips 20 just described above are inner since they are not facing away from each other or outside the peripheral edge. This however is not how inner or protected surfaces are defined in the claims. The claims recite that the inner surfaces are portions of the handles facing one another - not portions of the handles not facing away or not outside the peripheral edge. The surfaces of grips 20 facing one another do not include a convex end portion adjacent the free end.

Applicant is not arguing for limitations as indicated in Examiner’s second supplemental Answer. (See page 8, lines 1-3). On the contrary, applicant only argues that the combination of Bond and Ohno does not include the features of the claims as recited. Indeed, it appears the Examiner fails to account for each and every feature as specifically recited. The claims recite a

free end and inner surfaces distinctly and the indicia is located on the convex portion of the inner surface adjacent the free end and not at the free end.

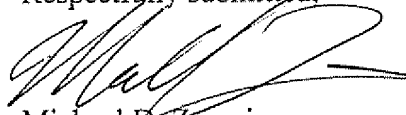
Lastly, even assuming that all the features of the present claims are disclosed in either Bond or Ohno separately, the evidence of a teaching, suggestion or motivation to combine the references which is a necessary requirement of the obviousness determination is glaringly omitted or missing from the rejections and Examiner's Answers. Indeed, Examiner misunderstands applicant's assertion that Bond is not concerned with protecting the indicia. According to the Examiner's second supplemental Answer applicant "argues that even if Ohno discloses the surfaces, the combination would not meet all of the limitations, since Bond is not concerned with protecting the indicia from wear." Applicant is not and has not made such an argument. Rather, applicant submits that there is no teaching, suggestion or motivation to combine the references. As already stated above, one motivation for placing the indicia at the location recited in the present claims is to protect them from wear. So, if Bond were to disclose protecting indicia from wear then an argument could be made that Bond may provide motivation to place indicia on an inner or protected surface of the tool disclosed by Ohno. However, not only is motivation wholly absent and not accounted for by the Examiner but such a combination (Bond and Ohno) would still lack a convex end portion. Consequently, there is no teaching or suggestion to combine nor does such a combination, if proper, result in meeting all the limitations as recited in the present claims

For the foregoing reasons, applicant respectfully requests that the rejection of the claims be reversed.

Application No. 10/688,449
Reply Brief Filed December 18, 2006

Applicant believes there are no fees due with this Reply Brief, however if any fees are necessary, the Commissioner is authorized to charge Deposit Account No. 50/1039.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael D. Laronias", written over a horizontal line.

Michael D. Laronias
Reg. No. 54,564

Dated: December 18, 2006

COOK, ALEX, McFARRON, MANZO,
CUMMINGS & MEHLER, LTD.
200 West Adams Street, Suite 2850
Chicago, Illinois 60606
(312) 236-8500

VIII. CLAIMS APPENDIX

1. A hand tool having two handles pivotably connected to one another, the handles terminating at a free end, each handle having first and second planar surfaces joined by inner and outer surfaces, said inner surfaces being the portions of said first and second handles facing each other, said inner surfaces being convex relative to one another at least at an end portion adjacent the free end, and indicia located on the convex end portion of the inner surface of at least one of said handles and indicating the type of said tool.

2. The hand tool of claim 1 wherein said indicia is located on the inner surface of both of said handles.

3. The hand tool of claim 1 further comprising a sleeve on at least one of said handles, and wherein the indicia is located on the portion of the sleeve that covers the inner surface of the handle.

4. The hand tool of claim 1 wherein the handles terminate in a tool head and the indicia indicates the size of the tool head.

5. The hand tool of claim 1 wherein the handles terminate in a tool head and the indicia indicates the type of the tool head.

6. A hand tool comprising first and second handle portions pivotably connected to one another and terminating at a free end, said handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, each handle terminating in a tool head portion, and an indicia located on a protected surface of at least one of said handles.

7. The hand tool of claim 6 wherein indicia are located on a protected surface of more than one of said handles.

8. The hand tool of claim 6 wherein said indicia is integral with said handle.

9. The hand tool of claim 6 further comprising a sleeve on each of said handles, wherein said indicia is located on one of said sleeves.

10. The hand tool of claim 9 wherein said indicia is integral with said sleeve.

11. A method of identifying a tool having at least two handles being pivotably connected to one another, the handles terminating at a free end, a tool head, and inner surfaces, said inner surfaces being the portions of said first and second handles facing each other and wherein said inner surfaces are convex relative to one another at least at an end portion adjacent the free end, said method comprising the step of placing an indicia on the convex end portion of the inner surface of at least one of said handles.

12. The method of claim 11 wherein said indicia indicates the type of said tool head.

13. The method of claim 11 wherein said indicia indicates the size of said tool head.

14. The method of claim 11 wherein said indicia is integrally formed with said handles.

15. The method of claim 11 wherein said tool further comprises a sleeve, and wherein said indicia is integrally formed with said sleeve.

IX. EVIDENCE APPENDIX

None.

0473

X. RELATED APPEALS APPENDIX

None.

PROVISIONAL PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(b)		Docket Number (Optional) 1110-0473
In re Application of Bruce P. Konen		
Application Number 10/688,449	Filed October 17, 2003	
For Pliers with Protected Indicia on the Handles		
Art Unit 3723	Examiner Hadi Shakeri	

This is a request for an extension of time of 19 days under 37 CFR 1.136(b) in this pending application. An extension of time is not available in this application under the provisions of 37 CFR 1.136(a); however, additional time to respond may still be granted under the patent statute. The petition fee under 37 CFR 1.17(g) is required. The reasons for requesting the extension of time are the following:

On November 29, 2006, the undersigned was editing and revising the Reply Brief in response to Examiner's Answer mailed on September 29, 2006, and first and second supplemental Examiner's Answers mailed on October 30, 2006 and November 14, 2006, respectively. The undersigned was called home from the office to help tend to his child's illness. The undersigned copied his digital certificate onto a portable USB drive to permit login to the Electronic Filing System from home for the purpose of electronically filing the Reply Brief. Although the undersigned was instructed prior to November 29, 2006 by personnel at the Electronic Business Center that the digital certificate could be transported and used from a home computer, the undersigned as an added measure of precaution took home a copy of previously obtained Recovery Codes which allow recovery of an otherwise inoperable digital certificate. A copy of the Recover Codes is provided as exhibit A. At around 10:00 p.m. central time on November 29, 2006, the undersigned completed all revisions and prepared to file the Reply Brief electronically. Several attempts were made to log in to the registered Electronic Filing System without success. The undersigned called the Electronic Business Center help desk for assistance. The help desk attendant informed the undersigned that the digital certificate may be expired. The undersigned then attempted to recover the digital certificate by using the Recovery Codes. The first step in this process is entry of an email address. The Electronic Filing System indicated that the email address entered was not recognized. A second attempt was made and this time the Electronic Filing System accepted the undersigned's email address and requested entry of the first unused Recovery Code. The undersigned entered Recovery Code A. The Electronic Filing System responded with what the undersigned remembers to be a server not found error page. Another attempt was made and after entry and acceptance of undersigned's email address, Recovery Code A was entered again. This time however, undersigned received a message stating that Recovery Code A had already been used and to use the next unused Recovery Code. The undersigned again attempted to recover the digital certificate and after entry and acceptance of undersigned's email address, the undersigned entered Recovery Code B. Again, the Electronic Filing System responded with what the undersigned remembers to be a server not found error page. At this point it was around 10:45 p.m. central time. The undersigned came to the conclusion that not enough time was available to seek assistance from the help desk and still have enough time to file the Reply Brief electronically prior to midnight eastern time. The undersigned believed there was just enough time to file the Reply Brief using first class mail and a Certificate of Mailing and to seek out a copying facility for appropriate record keeping. The undersigned rushed to amend the Reply Brief to include a signed Certificate of Mailing, to prepare the mailing envelope and to seek out a copy facility before midnight central of November 29, 2006. The undersigned found a copy facility to make copies of the Reply Brief and mailing envelope and proceeded to deposit the Reply Brief in a U.S. Postal Service drop box in Griffith Indiana approximately ten minutes prior to midnight central time on November 29, 2006. A copy of the Reply Brief and mailing envelope is included as exhibit B. The following day on November 30, 2006, the undersigned contacted the help desk to seek an explanation of why the recovery code system failed. The help desk attendant informed the undersigned that no outages were experienced and had no other explanation for the problems encountered by the undersigned the previous night. On December 15, 2006 at around 4:00 p.m., the undersigned's law firm personnel delivered to the undersigned the mailing of the Reply Brief which was returned by the U.S. Postal Service. A copy of the envelope marked by the U.S. Postal Service is included as exhibit C. It appears in the rush and anxiety to meet the midnight filing deadline on November 29, 2006, the undersigned used the address shown on the Reply Brief which had the incorrect city designation of Arlington. So although the mailing was properly addressed in all other aspects and the postal service itself recognized the

correct city was Alexandria as indicated by the marking of the U.S. Postal Service on the mailing envelope, the mailing was nevertheless returned. It is possible that had the mailing been done at a Chicago U.S. Postal facility, postal service employees having had more experience at handling correspondence to the Patent Office would have recognized the discrepancy and forward the Reply Brief to the Commissioner of Patents. Due to these unfortunate and extraordinary events, the undersigned respectfully requests that an extension under 1.136(b) be granted and that the Reply Brief attempted to be filed on November 29, 2006 and included as exhibit B be considered. Although this petition for an extension under 1.136(b) has not been filed prior to the expiration of the two-month time period following the mailing date of the first Examiner's Answer but within the two-month time period of either of the supplemental Examiner's Answer, undersigned acted extremely diligently once the need for an extension become apparent. The undersigned understands the requirement of allowing extensions of time only for cause with respect to Reply Briefs in response to an Examiner's Answer Briefs is due to the U.S. PTO's goal of expediting the Appeal process. The undersigned respectfully submits that the granting of the extension under 1.136(b) and acceptance of the undersigned's first attempted filing of the Reply Brief would not undermine the PTO's goal since the undersigned acted extremely diligently in trying to rectify an admitted error on the part of the undersigned - an error that occurred under very stressful and extraordinary series of events. Payment of the fee under 1.17(g) is authorized via a charge to Deposit Account 50-1039.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, or by imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of any patent application or any patent issuing thereon related to the matters herein addressed.



Signature

Michael D. Zaronias

Typed or printed name

Associate Attorney

Title

12-18-2006

Date

54,564

Registration Number

312-236-8500

Telephone Number

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EXHIBIT A



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Registered e-mail address: mzaronias@cookalex.com

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EXHIBIT B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)	
)	
Bruce P. Konen)	Art Unit: 3723
)	
Serial No.: 10/688,449)	Examiner: Hadi Shakeri
)	
Filed: October 17, 2003)	
)	
For: Pliers with Protected Indicia on)	
the Handles)	
)	
Confirmation No.: 1569)	

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents Commissioner for Patents P.O. Box 1450 on November 29, 2006.


Michael D. Zaronias
Registration No. 54,564

Commissioner for Patents
Box 1450
Arlington, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This Reply Brief is in response to Examiner's Answer mailed on September 29, 2006.

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I. REAL PARTY IN INTEREST

The real parties in interest in this appeal are IDEAL Industries Inc., assignee of the invention claimed in the above referenced application, which assignment was recorded in the United States Patent and Trademark Office at Reel No. 014627 and Frame No. 0967 on October 17, 2003.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-15 are currently pending and all have been finally rejected in the Office Action mailed November 25, 2005. Applicant is appealing the rejection of pending claims 1-15.

IV. STATUS OF AMENDMENTS

In response to the non-final Office Action mailed June 8, 2005. Applicants filed a response on September 8, 2005 which amended independent claims 1, 6 and 11. Subsequently, the final Office Action mailed November 25, 2005 acted on the previous amendment and finally rejected all the claims, 1-15. No amendments have been made following the final Office Action of November 25, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is generally directed to hand tools having indicia or markings used to identify the particular type of tool. More particularly, the invention relates to hand tools having indicia located on protected surfaces of one or more handles of the hand tool. The invention also encompasses a method of identifying a hand tool.

While it is known to place markers or indicia on a tool handle to indicate the type of tool, these markers or indicia are applied to areas of the tool handle that are susceptible to wear and abrasion and that are susceptible to being obscured by adjacent tools. See paragraph 0003.

To overcome these deficiencies, the subject matter of independent claims 1 and 6 is directed to a hand tool having two handles (10, 12) pivotally connected to one another and terminating at a free end. (See paragraph 0007 and FIGS. 1 and 2). Portions of the handle adjacent the terminating ends are convex and have inner surfaces (24) facing each other. (See paragraph 0008 and FIGS. 1 and 2). In normal, one-handed operation of the tool, the palm and fingers of a user's hand will wrap around and contact the first and second planar surfaces (18, 20) and the outer surfaces (22) of the handles but they will not engage the inner surfaces (24). (See paragraph 0008 and FIGS. 1 and 2). Since each inner surface is protected by the opposite handle, the inner surface is not subjected to wear or abrasion from a user's hand. (See paragraph 0008 and FIGS. 1 and 2). Accordingly, the inner surfaces are also referred to as protected surfaces. (See paragraph 0008).

Indicia or markings (26 or 28) are located on the convex end portion of the inner surface (24) of at least one of said handles (10 or 12) and indicating the type of the tool, or are located on a protected surface (24) of at least one of said handles (10 or 12). (See paragraph 0009 and FIGS. 1 and 2). Claim 11 is a method of identifying a tool having the above-described features except that the indicia are placed on the convex end portion of the inner surface (24) of at least one of said handles (10 or 12).

The advantages the hand tool of the present invention are at least twofold: The indicia or markings are less vulnerable to wear and abrasion which can result in making the marking

unintelligible (see at least paragraph 0008); and the indicia are less likely to be visually obscured by an adjacent tool (see at least paragraph 10 and FIG. 2).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-15 are unpatentable under 35 USC 103(a) over U.S. Patent No. 5,421,224 to Bond (hereinafter, Bond) in view of U.S. Patent No. 3,675,359 to Ohno (hereinafter, Ohno).

B. Whether claims 1-15 are unpatentable under 35 USC 103(a) over Ohno in view of Bond.

VII. ARGUMENT

A. The rejection of claims 1-15 under 35 USC 103(a) over Bond in view of Ohno and over Ohno in view of Bond is in error and must be reversed.

In order to find that claims 1-15 are obvious over a combination of references, it must be shown that the references in combination disclose all the features of the claims and evidence must be provided showing a teaching, suggestion or motivation to combine the references. Applicant submits that the combination of Bond and Ohno do not disclose all the features of the claims and even if the combination discloses all the features, which it does not, there is no evidence nor has there been any showing of evidence of a teaching, suggestion, or motivation to combine Bond and Ohno to arrive at the claimed subject matter.

The features of claim 1 include among others handles terminating at a free end, each handle having first and second planar surfaces joined by inner and outer surfaces, inner surfaces being the portions of said first and second handles facing each other, inner surfaces being convex relative to one another at least at an end portion adjacent the free end, and indicia located on the convex end portion of the inner surface of at least one of said handles. Claim 11 has

substantially the same features except that it is directed to a method of identifying a tool. The features of claim 6 include among others handle portions terminating at a free end, handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, and an indicia located on a protected surface of at least one of said handles.

Bond in Fig. 8 discloses pliers having indicia 70 on the terminal or butt end 72 and indicia 68, 69 on side or outer surfaces of the handles but clearly not on inner or protected surfaces as claimed in the present application. At a minimum, Bond does not disclose inner surfaces (surfaces facing one another) being convex relative to one another at least at an end portion adjacent the free end and indicia located on the convex end portion of the inner surface of at least one of said handles as recited in claims 1 and 11, and does not disclose handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, and an indicia located on a protected surface of at least one of said handles as recited in claim 6.

The handles disclosed in Ohno are similar to Bond except that instead of having butt ends the ends of the handle are tapered. The Ohno reference does not disclose inner surfaces (surfaces facing one another) being convex relative to one another at least at an end portion adjacent the free end and indicia located on the convex end portion as recited in claims 1 and 11, nor does it disclose handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, and an indicia located on a protected surface of at least one of said handles as recited in claim 6. Therefore, combining Bond and Ohno would still not meet all the limitations of the claims of the present invention.

Furthermore, there is no evidence of a teaching, suggestion or motivation to combine Bond and Ohno. One reason for having the convex end portion and indicia thereon is to be able to view the indicia from above when the tool is in a tool belt and to protect the indicia from wear. There is no disclosure in Bond or Ohno even suggesting the need to protect the indicia from wear. Accordingly, there is no teaching, suggestion or motivation to combine Bond or Ohno and even if combined there is no motivation to modify the tools disclosed in Bond and Ohno to place indicia on inner or protected surfaces or to modify the handles to have convex portions relative to one another as recited in the claims.

The Examiner maintains in the rejection and in the Examiner's second supplemental Answer specifically on lines 5-8 of the first paragraph of section 10 "Response to Argument" that "Bond meets the limitations, i.e., indicia (68) and (69) are on 'a' convex inner surface of the handle. i.e., mid-portion" except that "the convex inner surfaces disclosed by Bond do not face each other." These statements indicate either a misunderstanding of the claim limitations or reading limitations out of the claim. Indeed, on page 6 of the Examiner's second Supplemental Answer reference is made to "inner" surface (quotes in the original) as if the Examiner is not giving this term its common meaning as understood by skilled artisans and as defined by the specification but rather as a nondescript reference akin to labeling the structure as a "first" surface. Further, in order to describe a structure as convex or concave reference or relation must be made to something else. For example, the exterior surface of a football is convex or when viewed from the exterior, the surface is convex. The interior surface of the football is concave. The claims recite inner surfaces facing each other and inner surfaces being convex relative to one another, among other things. Neither Bond nor Ohno disclose handles having such features.

The Examiner also accuses applicant of attacking the references piecemeal or individually. This is clearly incorrect as applicant only points out the features which are disclosed and which are lacking in each reference in order to establish whether combining the references would disclose all the features of the present claims assuming there is a teaching, suggestion, or motivation to combine.

According to the second Supplemental Answer of the Examiner, "Bond as modified by Ohno would result in a pliers type tool having ergonomic handle grips meeting all the limitations as outlined by the Appellant." Specifically, the Examiner indicates that the feature of the claims - *the inner surfaces being convex relative to one another at least an end portion adjacent the free end* - is met by the structure "inner surfaces facing each other all along the length including at or adjacent to the distal end" in the tool of Bond modified by Ohno. (Emphasis added). First, the inner surfaces cannot include the distal or free end since the free ends and inner surfaces are distinctly claimed structures and if the inner surfaces extend to "adjacent the free end" then the those inner surfaces would could not be the *portions of the first and second handles facing each other* nor could those surfaces be *convex relative to one another*.

In addition, Examiner's second supplemental Answer indicates that the feature of the claims *indicia located on the convex end portion of the inner surface* is met by indicia 70 disclosed by Bond except that instead of butt end 72 the modified tool would have curved ends. However, this is not what is recited by the claims. The claims recite handles terminating at a free end and inner surfaces (surfaces facing one another), inner surfaces being convex relative to one another at least at an end portion adjacent the free end and the indicia on the convex end portion not on the free end as in the modified tool of Bond and Ohno. Also, Examiner attempts to indicate that Bond also discloses that the indicia could be placed at locations other than just the

butt end by citing several lines of Bond, which state that the indicia can be located “somewhere along the handle.” This statement in Bond however does nothing to assist in teaching the features of the present claims since this statement is made with respect to handle 12 of the screwdriver not the tool recited in the claims and Fig. 8 of Bond already shows indicia both on the butt end and along the handles of pliers. What is clear is that there is no disclosure on placing the indicia on inner surfaces (surfaces facing one another) and surfaces having a convex end portion even if the teaching of Ohno is combined with the teaching of Bond.

Furthermore, Examiner attempts to explain how Ohno discloses convex inner surfaces facing each other. According to the Examiner “grips 20 as disclosed in Figs. 2 and 3 (parallel lines at the inner edge), indicating convex surfaces facing each other from the proximal end to the distal end” and that applicant admits that Ohno has convex butt surfaces but that they are neither inner nor protected surfaces. First, applicant did not admit that Ohno has convex butt surfaces and applicant does not understand how the above statement indicates that grips 20 have inner surfaces including convex end portions. The Examiner indicates that the surfaces of grips 20 just described above are inner since they are not facing away from each other or outside the peripheral edge. This however is not how inner or protected surfaces are defined in the claims. The claims recite that the inner surfaces are portions of the handles facing one another - not portions of the handles not facing away or not outside the peripheral edge. The surfaces of grips 20 facing one another do not include a convex end portion adjacent the free end.

Applicant is not arguing for limitations as indicated in Examiner’s second supplemental Answer. (See page 8, lines 1-3). On the contrary, applicant only argues that the combination of Bond and Ohno does not include the features of the claims as recited. Indeed, it appears the Examiner fails to account for each and every feature as specifically recited. The claims recite a

free end and inner surfaces distinctly and the indicia is located on the convex portion of the inner surface adjacent the free end and not at the free end.

Lastly, even assuming that all the features of the present claims are disclosed in either Bond or Ohno separately, the evidence of a teaching, suggestion or motivation to combine the references which is a necessary requirement of the obviousness determination is glaringly omitted or missing from the rejections and Examiner's Answers. Indeed, Examiner misunderstands applicant's assertion that Bond is not concerned with protecting the indicia. According to the Examiner's second supplemental Answer applicant "argues that even if Ohno discloses the surfaces, the combination would not meet all of the limitations, since Bond is not concerned with protecting the indicia from wear." Applicant is not and has not made such an argument. Rather, applicant submits that there is no teaching, suggestion or motivation to combine the references. As already stated above, one motivation for placing the indicia at the location recited in the present claims is to protect them from wear. So, if Bond were to disclose protecting indicia from wear then an argument could be made that Bond may provide motivation to place indicia on an inner or protected surface of the tool disclosed by Ohno. However, not only is motivation wholly absent and not accounted for by the Examiner but such a combination (Bond and Ohno) would still lack a convex end portion. Consequently, there is no teaching or suggestion to combine nor does such a combination, if proper, result in meeting all the limitations as recited in the present claims.

For the foregoing reasons, applicant respectfully requests that the rejection of the claims be reversed.

Applicant believes there are no fees due with this Reply Brief, however if any fees are necessary, the Commissioner is authorized to charge Deposit Account No. 50/1039.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael D. Zaronas', written over a horizontal line.

Michael D. Zaronas
Reg. No. 54,564

Dated: November 29, 2006

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VIII. CLAIMS APPENDIX

1. A hand tool having two handles pivotably connected to one another, the handles terminating at a free end, each handle having first and second planar surfaces joined by inner and outer surfaces, said inner surfaces being the portions of said first and second handles facing each other, said inner surfaces being convex relative to one another at least at an end portion adjacent the free end, and indicia located on the convex end portion of the inner surface of at least one of said handles and indicating the type of said tool.

2. The hand tool of claim 1 wherein said indicia is located on the inner surface of both of said handles.

3. The hand tool of claim 1 further comprising a sleeve on at least one of said handles, and wherein the indicia is located on the portion of the sleeve that covers the inner surface of the handle.

4. The hand tool of claim 1 wherein the handles terminate in a tool head and the indicia indicates the size of the tool head.

5. The hand tool of claim 1 wherein the handles terminate in a tool head and the indicia indicates the type of the tool head.

6. A hand tool comprising first and second handle portions pivotably connected to one another and terminating at a free end, said handle portions being convex relative to one another at least at an end portion adjacent the free end and having protected surfaces facing one another on the convex end portion, each handle terminating in a tool head portion, and an indicia located on a protected surface of at least one of said handles.

7. The hand tool of claim 6 wherein indicia are located on a protected surface of more than one of said handles.

8. The hand tool of claim 6 wherein said indicia is integral with said handle.
9. The hand tool of claim 6 further comprising a sleeve on each of said handles, wherein said indicia is located on one of said sleeves.
10. The hand tool of claim 9 wherein said indicia is integral with said sleeve.
11. A method of identifying a tool having at least two handles being pivotably connected to one another, the handles terminating at a free end, a tool head, and inner surfaces, said inner surfaces being the portions of said first and second handles facing each other and wherein said inner surfaces are convex relative to one another at least at an end portion adjacent the free end, said method comprising the step of placing an indicia on the convex end portion of the inner surface of at least one of said handles.
12. The method of claim 11 wherein said indicia indicates the type of said tool head.
13. The method of claim 11 wherein said indicia indicates the size of said tool head.
14. The method of claim 11 wherein said indicia is integrally formed with said handles.
15. The method of claim 11 wherein said tool further comprises a sleeve. and wherein said indicia is integrally formed with said sleeve.

IX. EVIDENCE APPENDIX

None.

X. RELATED APPEALS APPENDIX

None.

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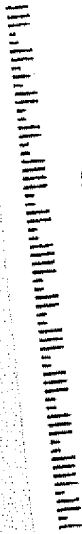
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